

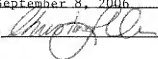
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

41232/S850

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Signature



Typed or printed name

Christina L. Vann

Application Number

09/788,069

Filed

February 16, 2001

First Named Inventor

Seth Weisberg, et al.

Art Unit

3621

Examiner

Firmin Backer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

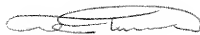
☒

attorney or agent of record.

Registration number 43,945
☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Raymond R. Tabandeh

Typed or printed name

626-795-9900

Telephone number

September 8, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐

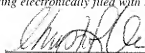
*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete the form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Christina L. Vann

Applicant : Seth Weisberg, et al. Confirmation No. 5093
Application No. : 09/788,069
Filed : February 16, 2001
Title : ON-LINE VALUE-BEARING INDICIUM PRINTING USING DSA
Grp./Div. : 3621
Examiner : Firmin Backer
Docket No. : 41232/S850

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Appeal Brief-Patents
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Pasadena, CA 91109-7068
September 8, 2006

Commissioner:

In support of the Pre-Appeal Brief Request for Review submitted herewith, the Applicant requests review for the following reasons:

I. The Examiner has committed a clear error in failing to establish that Lewis (U.S. 6,233,565) in view of Pang (U.S. 6,446,204) teach or suggest each of the elements of the claims.

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-41 are pending.

Appellant notes that the Final Office action mailed on August 30, 2006, is the eighth Office action that has been received for this case. In the sixth Office action mailed on October 21, 2005, the Examiner rejected all of the pending claims under 35 U.S.C. 102 (e) as being anticipated by **Lewis** (U.S. 6,233,565). Appellant filed a Notice of Appeal and Pre-Appeal Brief Request For Review on December 22, 2005, extensively discussing and distinguishing Lewis over the claimed invention.

The prosecution was re-opened on March 3, 2006 and a seventh Office action was mailed on April 17, 2006 rejecting all of the claims under 35 U.S.C. § 103(a) as being unpatentable over the same reference, **Lewis**, this time in view of Pang (U.S. 6,446,204). However, the seventh Office action failed to address any of the Applicant's arguments with respect to Lewis. Applicant filed response to the seventh Office action on June 13, 2006, again extensively discussing and distinguishing Lewis (and this time, Pang too) over the claimed invention. However, the subsequent (current) Final Office action is basically a duplicate of the previous Office action and still fails to address any of the three main arguments that Applicant made in their June 13, 2006 response.

In the Current Final Office action, claims 1-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis (U.S. 6,233,565) in view of Pang (U.S. 6,446,204). In order to establish a *prima facie* case of obviousness the Examiner must show that the cited references teach or suggest each of the elements of the claim.

Independent claims 1 and 30 include, among other limitations, "generating a textual representation of a digital signature from the message digest," "generating the indicium, wherein the indicium includes the textual representation of the digital signature and the 2-D bar code," and "each stateless cryptomodule being programmable to service any of the plurality of remotely located user computers." Appellant believes that the Patent Office has failed to establish that the cited references teach or suggest each of these elements of claims 1 and 30, and therefore has failed to establish a *prima facie* case of obviousness for claims 1 and 30.

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First, with respect to limitation of "generating a textual representation of a digital signature from the message digest," Lewis does not teach or suggest this limitation. Appellant respectfully submits that the Examiner has committed a clear error in asserting that FIGs. 4A and 4B of Lewis teach "a textual representation of a digital signature from the message digest." Because, the only textual representations in FIGs. 4A and 4B of Lewis are the meter number, the postage amount, the date, the class of postage, and an address, none of which is "a textual representation of a digital signature [generated] from the message digest." Additionally, as the Examiner admits, Pang does not cure the above deficiency of Lewis.

Second, with respect to limitation of "wherein the indicium includes the textual representation of the digital signature and the 2-D bar code," Lewis does not teach or suggest this limitation. Firstly, as discuss above, Lewis does not teach a textual representation of a digital signature. Secondly, Lewis does not teach an indicium that includes a textual representation of a digital signature and a 2-D bar code. Again, as the Examiner agrees, Pang does not cure the above deficiency of Lewis.

Third, with respect to limitation of "each stateless cryptomodule being programmable to service any of the plurality of remotely located user computers," as the Examiner agrees, Lewis does not teach this limitation. Appellant respectfully submits that the Examiner has committed a clear error in asserting that Pang teaches the above limitation. In the cited portion of Pang, a "system 600 includes an authentication server 252 that is connected to multiple dispatchers 214, 220 and 226 through object request broker 282. Authentication server 252 comprises an authentication engine 602, an authentication host 604 and a plurality of authentication service providers (simply referred to as providers) 606, 608, 610 and 612." (Col. 18, line 64 - col. 19, line 3, underlining added.).

The Examiner construes the authentication service providers 606, 608, 610 and 612 as the stateless cryptomodules of the claimed invention, however, Pang is very clear that these providers 606, 608, 610 and 612 can NOT "service any of the plurality of remotely located user computers." Rather, a request is forwarded to an appropriate provider and not any provider (col. 19, lines 13-14), because "[e]ach provider provides a specific authentication function to restrict access to a particular cartridge. For example, a BASIC provider may be associated with the

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authentication host and used to restrict cartridge access to only those browser requests that are associated with a particular username and password pair." (Col. 20, lines 25-31, underlining added.). Therefore, each provider of Pang can NOT "service any of the plurality of remotely located user computers." Consequently, the combination of Lewis and Pang does not teach or suggest the above limitation.

As a result, for at least the above **three reasons**, the Patent Office has failed to establish that the cited references teach or suggest all of the elements of the claims 1 and 30. Accordingly, it is respectfully requested that the obviousness rejection of claims 1 and 30 be overturned.

Independent claims 12 and 19 include, among other limitations, "each stateless cryptomodule programmable to service any remotely located user computer," "generating a text representation of a digital signature," and "generating the indicium, wherein the indicium includes the textual representation of the digital signature and the 2-D bar code." As described above neither Lewis nor Pang, alone or in combination teach or suggest the above limitations. As a result, independent claims 12 and 19 are also patentable in view of Lewis and Pang.

Independent claim 35 recites "A value bearing indicium (VBI) comprising: a 2-D barcode including relevant information; and a text representation of a digital signature generated from a message digest, the message digest generated using a secure hash algorithm to hash the relevant information, wherein the 2-D bar code excludes the digital signature." **First**, as discussed above, neither Lewis nor Pang, alone or in combination teach or suggest the limitation of "a text representation of a digital signature generated from a message digest." **Second**, neither Lewis nor Pang, alone or in combination teach or suggest the limitation of "wherein the 2-D bar code excludes the digital signature," because as clearly stated by Lewis, the 2-D bar code of FIGs. 4A and 4B includes the digital signature, in fact, the 2-D bar code is the digital signature.

As a result, for at least the above **two reasons**, the Patent Office has failed to establish that the cited references teach or suggest all of the elements of the claim 35. Accordingly, it is respectfully requested that the obviousness rejection of claim 35 be overturned also.

In short, the independent claims 1, 12, 19, 30 and 35 define a novel and unobvious invention over the cited references. Dependent claims 2-11, 13-18, 20-29, 31-34, and 36-41 are dependent from allowable claims 1, 12, 19, 30 and 35, respectively and therefore include all the


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limitations of their respective independent claims and additional limitations therein. Hence, these claims are also allowable over the cited references, as being dependent from allowable independent claims 1, 12, 19, 30 and 35 and for the additional limitations they include therein. Accordingly, it is respectfully requested that the obviousness rejection of these claims be overturned.

In short, Appellant respectfully submit that the Examiner has committed a clear error in failing to establish that Lewis in view of Pang teach or suggest each of the elements of the claims 1-41 and therefore respectfully requests that the obviousness rejection of claims 1-41 be overturned.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

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626/795-9900

RRT/clv

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